


In the Claims: (strikethrough parts deleted and underlined parts added)

Please delete Claims 1-6 without prejudice.

1. (Canceled)
2. (Canceled)
3. (Canceled)
4. (Canceled)
5. (Canceled)
6. (Canceled)

7. (Currently Amended) A method of using a remote control multimedia content listing system ~~system having an electronic system with a communication device, an input device, a display, and a means for communicating with a control station~~, said method comprising the steps of:

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- (a) entering a media record into said an electronic system, wherein said electronic system is capable of controlling one or more electronic devices;
 - (b) storing said media record within said electronic system ~~into a media storage~~;
 - (c) repeating steps (a) and (b) for additional media records;
 - (d) uploading said media record storage to said control station;
 - (e) determining an identity of media that corresponds with each said media record ~~of said media storage~~; and
 - (f) generating a configuration data for said electronic system that allows said electronic system to display a media guide, and wherein said configuration data determines what control signals are transmitted by said electronic system to at least one electronic device based upon a media selection for activating said media selection.

8. (Original) The method of using a remote control multimedia content listing system of Claim 7, including the step of:

- (g) transferring said configuration data to said electronic system.

9. (Original) The method of using a remote control multimedia content listing system of Claim 8, including the step of:

(h) storing said configuration data within said electronic system.

10. (Original) The method of using a remote control multimedia content listing system of Claim 9, including the step of:

(i) displaying said media guide upon said display.

11. (Currently Amended) A method of using a remote control multimedia content listing system ~~having an electronic system with a communication device, an input device, a display and a means for communicating with a control station~~, said method comprising the steps of:

- a
- (a) accessing a web page of ~~said~~ a control station;
 - (b) inputting media data into said web page; and
 - (c) generating a configuration data for said electronic system that allows said electronic system to display a media guide, and wherein said configuration data determines what control signals are transmitted by said electronic system to at least one electronic device based upon a media selection for activating said media selection.

12. (Currently Amended) The method of using a remote control multimedia content listing system of Claim 11, including the step of:

- (d) transferring said configuration data to ~~said~~ an electronic system, wherein said electronic system is capable of controlling one or more electronic devices.

13. (Original) The method of using a remote control multimedia content listing system of Claim 12, including the step of:

- (e) storing said configuration data within said electronic system.

14. (Original) The method of using a remote control multimedia content listing system of Claim 13, including the step of:

(f) displaying said media guide upon said display.

15. (Original) The method of using a remote control multimedia content listing system of Claim 11, wherein said media guide includes a television guide.

16. (Original) The method of using a remote control multimedia content listing system of Claim 11, wherein said media guide includes a music guide.

17. (Original) The method of using a remote control multimedia content listing system of Claim 16, wherein said music guide is comprised of information relating to music media contained within a user's home stereo system.

18. (Original) The method of using a remote control multimedia content listing system of Claim 16, wherein said music guide is comprised of information relating to compact discs contained within a user's home stereo system.

19. (Original) The method of using a remote control multimedia content listing system of Claim 18, including the steps of:

- (d) selecting a media event to be displayed or listened to by said user;
- (e) transmitting a control signal to an electronic device to play said media event.

[Please add the following claims:]

20. (New) A method of programming a remote control, wherein said remote control is capable of controlling at least one electronic device, said method comprising:

accessing a control station;

inputting at least one media data into said control station;

generating a configuration data by said control station for said remote control that allows said remote control to display a media guide, and wherein said configuration data determines what control signals are transmitted by said remote control to at least one electronic device based upon a media selection for activating said media selection;

transferring said configuration data to said remote control;

selecting a media event to be accessed upon at least one electronic device; and

transmitting a control signal from said remote control to at least one electronic device to play said media event based upon said configuration data.

21. (New) The method of programming a remote control of Claim 20, including the step of storing said configuration data within said remote control.

22. (New) The method of programming a remote control of Claim 20, including the step of displaying said media guide upon a display within said remote control.

23. (New) The method of programming a remote control of Claim 20, wherein said media guide includes a television guide.

24. (New) The method of programming a remote control of Claim 20, wherein said media guide includes a music guide.

25. (New) The method of using a remote control multimedia content listing system of Claim 24, wherein said music guide is comprised of information relating to music media contained within a user's home stereo system.

C. APPLICANT'S COMMENTS

Claims 7-19 are pending in this Application, with Claims 7, 11, 12 being amended and Claims 20-25 being added. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 7-19 and favorable consideration of Claims 20-25 is respectfully requested.

The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

First 35 U.S.C. §102(b) Rejection (Claims 1-2)

The Official Action rejected as-filed Claims 1-2 under 35 U.S.C. §102(b) as being anticipated by August et al. The Applicant has deleted Claim 1-6 without prejudice.

Second 35 U.S.C. §102(b) Rejection (Claims 7-15)

The Official Action rejected as-filed Claims 7-15 under 35 U.S.C. §102(b) as being anticipated by Brotz (U.S. Patent No. 6,374,404). The Applicant respectfully disagrees with this rejection.

It is important to first briefly discuss 35 U.S.C. §102 and its application to the present application. Under section 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art. In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987) (emphasis added). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

Amended independent Claim 7 has the following features which are not shown in any of the prior art references:

7. (Currently Amended) A method of using a remote control multimedia content listing system, said method comprising the steps of:

- (a) **entering a media record into an electronic system**, wherein said electronic system is capable of controlling one or more electronic devices;
- (b) storing said media record within said electronic system;
- (c) repeating steps (a) and (b) for additional media records;
- (d) **uploading said media record to said control station**;
- (e) **determining an identity of media that corresponds with each said media record**; and
- (f) **generating a configuration data for said electronic system that allows said electronic system to display a media guide, and wherein said configuration data determines what control signals are transmitted by said electronic system to at least one electronic device based upon a media selection for activating said media selection.**

Amended independent Claim 11 has the following features which are not shown in any of the prior art references:

11. (Currently Amended) A method of using a remote control multimedia content listing system, said method comprising the steps of:

- (a) accessing a web page of a control station;
- (b) **inputting media data into said web page; and**
- (c) **generating a configuration data for said electronic system that allows said electronic system to display a media guide, and wherein said configuration data determines what control signals are transmitted by said electronic system to at least one electronic device based upon a media selection for activating said media selection.**

Brotz merely teaches a system for “caching web pages” and not a method of using a remote control multimedia content listing system as with the present invention. Brotz is not only non-analogous to the present invention, but Brotz also does not teach all of the elements of independent Claims 7, 11 (or added Claim 20).

More particularly, Brotz does not teach the entering of media data into an electronic system or a web page, much less the uploading of the media data to a control station. In Brotz, the user merely enters a “URL of desired web page” which is not media data. (Figure 5). The present invention allows for the entry of media data contained upon one or more electronic devices (e.g. CD’s, DVDs and the like). Brotz simply does not teach this limitation.

Further, Brotz does not determine “*an identity of media that corresponds with each said media record*”. Finally, Brotz does not generate “*a configuration data for said electronic system that allows said electronic system to display a media guide, and wherein said configuration data determines what control signals are transmitted by said electronic system to at least one electronic device based upon a media selection for activating said media selection.*” This is a specific feature of the independent claims that should not be overlooked.

The Applicant respectfully submits that Brotz does not qualify as appropriate prior art under 35 U.S.C. §102(b) as Brotz does not disclose (expressly or inherently) all of the elements of independent Claims 7-25.

35 U.S.C. §103 (Claims 16-19)

The Official Action rejected Claims 16-19 under 35 U.S.C. §103(a) as being unpatentable over Brotz in view of Graczyk (U.S. Patent No. 6,628,340). The above-stated arguments are incorporated by reference into this section. The Applicant respectfully disagrees with this rejection of these claims (and as potentially applied to added Claims 20-25).

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned upon appeal. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

"To establish a prima facie case of obviousness, three basic criteria must be met." MPEP §706.02(j). First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

The Official Action stated that Brotz does not disclose a "music guide", however that Graczyk teaches "wherein the media guide includes a music guide (col. 5, lines 15-26) in order to provide music to entertain the user." The Applicant has reviewed Column 5, Lines 15-26

(Graczyk) and it is respectfully submitted that there is no discussion of a “media guide” or a “music guide”. The Applicant respectfully submits that this important feature of Claim 16 is not shown or suggested in Graczyk.

The Official Action further stated that Graczyk discloses “wherein said music guide is comprised of information relating to music media contained within a user’s home stereo system (col. 12 lines 60-65 and col. 20 lines 39-40).” The Applicant has reviewed Column 12, Lines 60-65 and Column 20, Lines 39-40 of Graczyk and it is respectfully submitted that there is no discussion of “information relating to a music media contained within a user’s home stereo system”. The Applicant respectfully submits that this important feature of Claim 17 is not shown or suggested in Graczyk.

Finally, the Official Action stated that Graczyk discloses “wherein said music guide is comprised of information relating to compact discs contain within a user’s home stereo system (col. 20 lines 39-41).” The Applicant has reviewed Column 20, Lines 39-41 of Graczyk and it is respectfully submitted that there is no discussion of “information relating to compact discs contain within a user’s home stereo system”. The Applicant respectfully submits that this important feature of Claim 18 is not shown or suggested in Graczyk.

For these reasons, among others, the combination of Brotz with Graczyk cannot suggest the combination of features in applicant’s Claims 16-19, and it is therefore submitted that the rejection against these claims should be withdrawn and Claims 16-19 allowed.

Added Claims 20-25

The Applicant has added independent Claim 20 along with dependent Claims 21-25. The Applicant incorporates the above-stated arguments with respect to added Claims 20-25.